

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Dipoto et al. Art Unit : 3731
 Serial No. : 09/447,228 Examiner : Victor X. Nguyen
 Filed : Nov. 11, 1999
 Title : SUTURE ANCHOR AND DRIVE ASSEMBLY

Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

REQUEST FOR RETURN OF ORIGINAL LETTERS PATENT

Application Ser. No. 09/447,228 was filed as a reissue of application Ser. No. 08/509,966, which issued as U.S. Pat No. 5,690,676 on Nov. 25, 1997. U.S. Pat No. 5,690,676 has since expired.¹ As *In re Morgan*, 990 F.2d 1230, 1231 (Fed. Cir. 1993) clarifies, a reissue proceeding cannot continue following the expiration of the underlying patent.²

Applicant submitted the original letters patent upon filing the reissue application and, as the reissue proceeding cannot continue, hereby requests its return. MPEP § 1416 states that “where the patentee has submitted the original letters patent in a reissue application subject to 37 CFR 1.178 as it is now amended,” the original letters patent will be returned if “it can be readily retrieved from where it is stored.” 37 CFR 1.178 was amended effective Oct. 21, 2004, but applies retroactively to all pending applications. MPEP § 1416. As such, 37 CFR 1.178 applies

¹ Application Ser. No. 08/509,966 was a continuation of application Ser. No. 08/091,092, filed Jul. 12, 1993, now abandoned, which was a divisional of application Ser. No. 07/836,679, filed Feb. 14, 1992, now U.S. Pat. No. 5,258,016 which was a continuation-in-part of application Ser. No. 07/681,042, filed Apr. 5, 1991, now abandoned, which was a continuation-in-part of application Ser. No. 07/552,440, filed Jul. 13, 1990, which issued as U.S. Pat No. 5,100,417. Application Ser. No. 08/509,966 was filed after Jun. 8, 1995, on Nov. 11, 1999. As such, its term expired on Jul. 13, 2010, twenty years from the date on which the earliest referenced application was filed. See MPEP § 2107.

² *See Id.* (“The language of section 251 is unambiguous: the Commissioner has authority to reissue a patent only ‘for the unexpired part of the term of the original patent.’ Thus, when *Morgan's* original patent expired on August 19, 1992, the Commissioner was divested of his reissue authority because there no longer was an unexpired term of the patent for which *Morgan's* patent could be reissued”). See also MPEP § 1415.01 (“35 U.S.C. 251, first paragraph, only authorizes the granting of a reissue patent for the unexpired term of the original patent. Once a patent has expired, the Director of the USPTO no longer has the authority under 35 U.S.C. 251 to reissue the patent”).

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to application Ser. No. 09/447,228, and Applicant can therefore expect the return of the original letters patent.³ Please return the original letters patent at your earliest convenience.

No fee is believed to be due. If, however, there are any charges or credits, please apply them to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 11/03/10



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³ Even if application Ser. No. 09/447,228 were to be considered abandoned at the time of this request, the policy of the United States Patent and Trademark Office supports the return of the original letters patent in this case. *See* MPEP § 1416 ("Example 6: A reissue application was pending at the time of the effective date of the amendment to 37 CFR 1.178, and an original letters patent was submitted. Applicant requests return of the original letters patent, although the application is abandoned at the time the request for return is made. In this instance, the Office would return the original letters patent if *it is readily retrievable*") (emphasis in original).